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10/688,449	10/17/2003	Bruce P. Konen	1110-0473	1569

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EXAMINER

SHAKERI, HADI

ART UNIT	PAPER NUMBER
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3723

DATE MAILED: 09/29/2006

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/688,449  
Filing Date: October 17, 2003  
Appellant(s): KONEN, BRUCE P.

**MAILED**  
**SEP 29 2006**  
**GROUP 3700**

\_\_\_\_\_  
Joel H. Bock  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed July 25, 2006 appealing from the Office action mailed November 25, 2005.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

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**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

5,421,224	BOND	06-1995
3,675,359	OHNO	07-1972

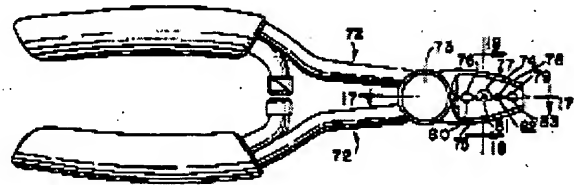
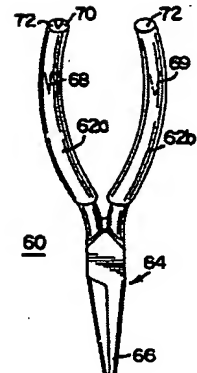
**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-15 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Bond (5,421,224) in view of Ohno (3,675,359).

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Bond meets all of the limitations of claims 1, 6 and 11, i.e., a hand tool having two handles (72), each handle having first and second planar surfaces joined by inner and outer surfaces, and indicia (68) (69) located on the inner surface of at least one of said handles and indicating the type of said tool and wherein first and second handle portions pivotably connected to one another, each handle terminating in a tool head portion, wherein said indicia is located on the inner surface of both of said handles, except for disclosing a handle having convex portions relative to each other and placing the indicia on an inner surface of the convex portions.



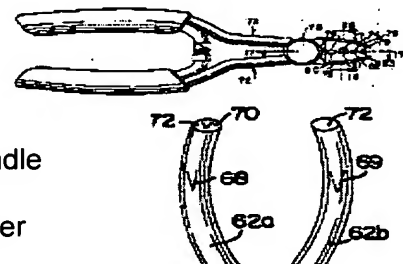
Pliers with handle grips having convex distal ends are old and known, e.g., as evident by Ohno.

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to modify the invention of Bond with the ergonomically shaped grips as taught by Ohno for comfort. Note that the disclosure of Bond for placing the indicia (70) at the end of the grip for the ergonomically shaped handle grips would meet the limitations as recited.

Modified prior art also discloses that the indicia may be integrally formed on the handle or alternatively molded onto and raised from the handle meeting the limitations of claims 3, 9, 10 and 15.

Claims 1-15 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Ohno in view of Bond.

Ohno meets all of the limitations of claims 1, 6 and 11, i.e., pliers shaped hand tools having two handles, each handle having first and second planar surfaces joined by inner and outer



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surfaces, with convex inner surfaces, except for disclosing indicia. Bond teaches placing indicia (70) located on a distal end of the handles indicating the type of the pliers.

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to modify the invention of Ohno with the indicia as taught by Bond to adapt the tool with marking indicating the type and/or the size of the tool.

Modified prior art also discloses that the indicia may be integrally formed on the handle or alternatively molded onto and raised from the handle meeting the limitations of claims 3, 9, 10 and 15.

#### **(10) Response to Argument**

With regards to the rejection of Bond in view of Ohno, Appellant argues that first, "Bond does not disclose indicia on the inner surface of the both handles", section VII, first line of the second paragraph. This is not persuasive, firstly, the independent claims 1, 6 and 11, recite for the indicia to be "on the convex end portion of the inner surface at least one of said handles", (line before the last). With respect to the indicia being on the convex inner surface, Bond meets the limitations, i.e., indicia (68) and (69) are on "a" convex inner surface of the handle, i.e., mid-portion, however, the convex inner surfaces as disclosed by Bond do not face each other, as defined by the appealed claimed invention. However argument regarding this limitation is not persuasive, since Bond is not applied as anticipating the claims, and the combination as applied to the claims meet this limitation as explained below. Second Appellant argues that Bond does not provide any disclosure or suggestions to protect the indicia. This argument is not persuasive either, because whether or not the Appellant is correct, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985). Bond as modified by Ohno and

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as explained below meets all of the limitations, including placing the indicia on at least one handle on the convex inner surfaces facing each other. Appellant continues with "piecemeal analysis" by attacking Ohno, firstly it is note that in response to Appellant 's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Appellant argues against Ohno by first stating that convex distal ends of the handle is not a feature recited by the appealed claims, lines 2 and 3 of the second paragraph on page 6 of 13. Examiner is not arguing for this feature, only that grips having a convex distal ends are known in the art as evident by Ohno, and that Bond already discloses convex "inner" surface for the handle, only that the indicia placed on these surfaces do not face each other. Appellant further argues against Ohno that it fails to disclose, discuss, show or suggest of indicia whatsoever. This argument is not persuasive as it attacks the reference individually, whereas the combination is applied to the claims. Finally Appellant argues against the combined references that

*"[s]pecificlly, the combination would still not teach or suggest at least the features of: handles having inner surface, which are the portions of the first and second handles facing each other, the inner surfaces being convex relative to one another at least at an end portion adjacent the free end; and indicia located on the convex end portion of the inner surface as recited in claims 1 and 11."* page 6 of 13, lines 17-21.

Bond as modified by Ohno, would result in a pliers type tool, having ergonomic handle grips meeting all the limitations as outlined by the Appellant, i.e., *handles having inner surface; surfaces along the proximal end, adjacent to the head, down to the distal end or the free end; which are the portions of the first and second handles facing each other; the portions facing*

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each other; *the inner surfaces being convex relative to one another at least at an end portion adjacent the free end*; the inner surfaces facing each other all along the length including at or adjacent to the distal end; *and indicia located on the convex end portion of the inner surface*; i.e., indicia (70) as disclosed by Bond, placed on the "blunt end", now the combined references lack a "blunt end" rather curved ends. However, not only placing the indicia (70) on the curved (convex inner surfaces facing each other) end is disclosed by Bond, since placing the indicia on an end portion of the handle is outmost important to Bond, because it contemplates using the indicia in conjunction with a tool belt or pouch, wherein the butt will face up and be in user's line of vision (emphases added, see Bond column 5, lines 56-68), but also Bond, specifically discloses placing the indicia on the butt or somewhere along the end of the handle (emphases added 05:68), disclosing embodiments meeting the claims. Thus contrary to the Appellant statement Bond would not require modifications both to the location of indicia and the type of the handle, only the latter. The argument, that it would be improper to combine the references, since Bond teaches away from placing the indicia on an inner or protected surface as recited in the claims, because placing the indicia on the inner surface would not be visible and could not identify the tool when stored in a belt or pouch, is not persuasive, since while indicia (68) (69) would be placed on a convex inner surfaces not facing each other (upper and lower sides), indicia (70) would have to be place on the end or near end (as disclosed by Bond), i.e., convex inner surfaces facing each other, just like Figs. 1 or 2 of the instant application, to be visible from the above, because it has to be faced up (Bond 05:62).

The argument against the combination of Ohno in view of Bond is that, firstly Ohno does not disclose convex inner surfaces. This is not persuasive, since Ohno clearly discloses convex inner surfaces facing each other, i.e., grips (20) as disclosed in Figs. 2 and 3 (parallel lines at the inner edge), indicating convex surfaces facing each other from the proximal end to the distal

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end. Further Appellant admits that Ohno has convex butt surfaces but there are not either inner or protected surface, which is in error since they are inner as opposed to the surfaces facing away from each other or outside peripheral edge, and they are protected surfaces, i.e., as defined by the instant application, not meant to be grasped during normal usage. Appellant apparently is arguing for limitations, e.g., definition of inner surfaces not including the ends or near the ends, even though claims recite for the surfaces to be at an end portion. Then Appellant argues that even if Ohno discloses the surfaces, the combination would not meet all of the limitations, since Bond is not concerned with protecting the indicia from wear. This argument is not persuasive, since as indicated above, placement of indicia (70) for the pliers type tool of Ohno for indicating the type of the pliers (fish mount implements) in a tool belt or pouch verses other types of pliers, meets the limitations, the fact that the motivation is for a line of sight, and not for the reasons as intended by the instant Application, does not exclude the combined references in reading over the claims as recited. Placement of indicia (70) on the Ohno's convex butt ends (as admitted by the Appellant), modification clearly disclosed by Bond, would not be visually obscured while the mid-portions indicia (68) (69) may be.

**(11) Related Proceeding(s) Appendix**


No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

  
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Art Unit 3723

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